

REMARKS

At the outset, Applicant thanks the Examiner for the thorough review and consideration of the pending application. The Office Action dated April 5, 2005 has been received and its contents carefully reviewed.

Claims 1, 14, 40, 42, and 48 are hereby amended; claims 46, 47, and 49-53 are hereby canceled; and claim 54 is hereby added. Accordingly, claims 1, 4, 14, 16, 20, 21, and 40-45, 48, and 54 are currently pending. Reexamination and reconsideration of the pending claims is respectfully requested.

In the Office Action, the Examiner withdrew subject matter recited within previously presented claims 46-53 from consideration as being allegedly directed to a non-elected invention. Specifically, the Examiner alleged the subject matter within newly submitted claims 46-53 (Species II: generally involving two uniaxial optical compensation films with a phase difference of 30-40 nm and a difference in anisotropic refractive indices in an optical compensation film is 0.005-0.006) was directed to an invention that is independent or distinct from the invention as originally claimed in claims 1, 4, 14, 16, 20, 21, and 40-45 (Species I: generally involving two uniaxial optical compensation films of a same type and having the same ordinary refractive index). Because Applicant previously received an action on subject matter recited by the claims of Species I, the Examiner asserts that Species I has been "constructively elected by original presentation." Applicant respectfully traverses the merits of this election by original presentation.

First, and as set forth at M.P.E.P. § 821.03, claims added by amendment following action by the Examiner, to an invention other than previously claimed, should be treated as indicated by 37 CFR § 1.145. § 1.145 states:

If, after an office action on an application, the applicant presents claims directed to an invention **distinct from and independent of** the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered.... (**emphasis added**)

Second, and as set forth at M.P.E.P. 816, the particular reasons relied on by the Examiner for holding that the inventions as claimed are either independent or distinct should be

concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

Nevertheless, the Examiner attempts to withdraw the claims of Species II merely by reciting the “specifics” of the two Species. Applicant respectfully submits, however, that merely describing differences between two groups of claims does not establish that the two inventions are independent of each other (see M.P.E.P. § 808.01(a)) or that they are distinct (see M.P.E.P. 806.05, and 806.05(a)-(i)). Moreover, even if it could be shown that the inventions of Species I and II were distinct (i.e., not related), the Examiner must still establish some reason enumerated within M.P.E.P. § 808.02(A)-(C) for insisting upon the restriction. In view of the above, Applicant respectfully submits the Examiner has failed to establish that the subject matter within the claims of Species II are directed to an invention that is independent or distinct from the invention originally claimed in the claims of Species I. Absent the requisite showing on the part of the Examiner, Applicant respectfully requests the Examiner’s consideration of the subject matter within previously presented claims 46-53 (now incorporated within claims 1, 14, 40, and 42).

Further, Applicant respectfully directs the Examiner’s attention to M.P.E.P. § 806.04(f), stating that claims “to be restricted to different species must be mutually exclusive.” Applicant respectfully submits that the subject matter recited within the claims of Species I and the within claims of Species II are not mutually exclusive (see, for example, the present application, Figures 2, 5a, 5b, 6a, 6b, and 9; and pages 5-8, 10, and 11). For at least this additional reason, Applicant respectfully requests the Examiner’s consideration of the subject matter within previously presented claims 46-53 (now incorporated within claims 1, 14, 40, and 42).

In the Office Action, the Examiner rejected claims 1, 14, 40, and 42 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Akatsuka et al. (U.S. Patent No. 5,406,396). This rejection is respectfully traversed and reconsideration is requested.

As set forth in M.P.E.P. § 2143.03, a *prima facie* case of obviousness is established when, at least, all the features of the claim are taught or suggested by the applied reference(s).

Applicant respectfully submits that Akatsuka et al. fails to teach or suggest each and every element as presently recited in claims 1, 14, 40, and 42. For example, Akatsuka et al. fails to teach or suggest two uniaxial optical compensation films, over the second substrate, “wherein an ordinary refractive index of each of the two uniaxial optical compensation films is the same, wherein a phase difference between the two compensation films is 30-40 nm, and wherein a difference in anisotropic refractive indices of an optical compensation film is 0.005-0.006 such that a viewing angle larger than 40° is achieved,” as presently recited in each of claims 1, 14, 40, and 42. For at least this reason, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 4, 16, 41, and 43 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Akatsuka et al. in view of Arakawa (U.S. Patent No. 5,189,538). This rejection is respectfully traversed and reconsideration is requested.

Claims 4, 16, 41, and 43 depend from claims 1, 14, 40, and 42, respectively, which as discussed above, are patentable over Akatsuka et al. Arakawa is asserted by the Examiner as disclosing features recited by dependent claims 4, 16, 41, and 43. Without reaching the merits of this assertion, Applicant respectfully submits that Arakawa fails to cure the above-cited deficiency of Akatsuka et al. as applied to independent claims 1, 14, 40, and 42 above. Therefore, Applicant respectfully submits that claims 4, 16, 41, and 43, which depend from claims 1, 14, 40, and 42, are patentable over Akatsuka et al. in view of Arakawa.

In the Office Action, the Examiner rejected claims 20, 21, 44, and 45 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Akatsuka et al. in view of Sugiyama et al. (U.S. Patent No. 5,757,455). This rejection is respectfully traversed and reconsideration is requested.

Claims 20, 21, 44, and 45 depend from claims 1, 14, 40, and 42, respectively, which as discussed above, are patentable over Akatsuka et al. Sugiyama et al. is asserted by the Examiner as disclosing features recited by dependent claims 20, 21, 44, and 45. Without reaching the merits of this assertion, Applicant respectfully submits that Sugiyama et al. fails to cure the above-cited deficiency of Akatsuka et al. as applied to independent claims 1, 14, 40, and 42 above. Therefore, Applicant respectfully submits that claims 20, 21, 44, and 45, which

depend from claims 1, 14, 40, and 42, are patentable over Akatsuka et al. in view of Sugiyama et al.

Applicant believes the foregoing amendments and remarks place the application in condition for allowance and early, favorable action is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: July 5, 2005

Respectfully submitted,

By Penny L. Caudle
Penny L. Caudle

Registration No.: 46,607
MCKENNA LONG & ALDRIDGE LLP
1900 K Street, N.W.
Washington, DC 20006
(202) 496-7500
Attorney for Applicant